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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Calcium Software Limited

Serial No. 78377250

Edward J. Chalfie of Ladas & Parry for Calcium Software Limited.

Florentina Blandu, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Zervas, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On March 2, 2004, Calcium Software Limited filed an application to register on the Principal Register the mark MAILPRIMER (in standard character form) for "[m]ultimedia messaging software; computer software for the writing, sending, storage, processing, control, organization and/or management of email and other forms of communication" in

International Class 9.¹ The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark PRIMER for "[s]oftware enabling documents to be read on hand-held computers and Internet appliances" in International Class 9.²

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing. As discussed below, the refusal to register is affirmed.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the

¹ Application Serial No. 78377250.

² Registration No. 2493576, issued September 25, 2001.

similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the similarities and dissimilarities between the marks. Specifically, we consider whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The cited mark consists of the term PRIMER and applicant's mark includes the term PRIMER, preceded by the term MAIL. The only difference between the two marks is applicant's addition of the term MAIL to registrant's mark. As is clear from the identification of goods, applicant's goods are intended to be used in connection with mail, specifically, electronic mail or email. The dictionary definition of "mail," of which we take judicial notice, includes "... messages sent electronically; e-mail." *American Heritage Dictionary of the English Language*

(2003).³ Because applicant's goods are used in connection with email, at a minimum, MAIL in applicant's mark is a descriptive term. As such, MAIL is accorded less weight in determining the similarities or dissimilarities of the marks.⁴

Additionally, the connotation and commercial impression of applicant's mark taken as a whole is that applicant's PRIMER software is intended to be used in connection with mail. This connotation and commercial impression is reinforced by the manner in which applicant

³ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ Applicant, with its response to the first Office action, submitted a list of seven registrations that contain the term PRIMER alone or within a mark, e.g., PRIMERIDIAN (Registration No. 2725688) and PRIMEREAD (Registration No. 2867541). Applicant argues that these registrations "illustrate the lack of distinctiveness of this 'dominant element.'" Brief at p. 6. To make third-party registrations of record, applicant must submit a copy of the registration or a printout from the USPTO's electronic database prior to the briefing stage of the case. *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record."). However, the examining attorney has not objected to this listing of registrations (including the marks and goods) or advised applicant that the listing is insufficient to make the registrations of record at a point when applicant could have corrected the error. See TBMP § 1208.02. We therefore have considered the registrations, but only to the extent of the information provided.

Applicant's listing of registrations has limited probative value because several of the subject marks do not contain PRIMER as a term in and of itself, which thus creates a different commercial impression; and because the remaining marks are too few in number to be persuasive.

uses MAILPRIMER on applicant's webpage, i.e., as "mailPrimer," suggesting that the particular version of PRIMER software is used for mail or email purposes.

Thus, although there are differences in appearance and sound when the marks are considered as a whole, the similarities in meaning and commercial impression outweigh such differences. We therefore conclude that the marks are more similar than dissimilar when considered in their entireties and that the nondescriptive portion of applicant's mark is identical to registrant's mark.

Next, we consider the similarities and dissimilarities of the goods identified in the application and the cited registration. We must consider registrant's goods as they are described in the registration and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all channels of trade normal for these goods or services, and

that they are available to all classes of purchasers for the described goods or services. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

The examining attorney maintains that the goods are related because they are both software which enable "people to view information that is made available electronically." The examining attorney cites to several registrations and applications that she maintains show that providers of software for reading information also provide software used to write and/or store documents. Brief at pp. 3-4. Third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Specifically, the examining attorney relies on the following:

Registration No. 2815823 for FIBREJET and design for computer software for, in relevant part, providing information storage networking that allow "secure read and write access to designated electronic files stored on commonly accessible electronic storage devices when these devices would normally be arrayed in a centralized storage environment or a storage area network";

Registration No. 2390970 for BEATWARE for "computer software, namely ... computer programs used to read, write, send and receive electronic messages, text and data, and computer programs for use in word processing and spreadsheet applications";

Registration No. 2854035 for SIMTELLIGENCE for, inter alia, memory cards for "computer operating systems, computer programs and computer software for data processing, especially for mobile telecommunications systems," and "electronic data processing software for interfacing with smart cards in specific computers and in conjunction with read and write systems for smart cards"; and

Registration No. 2408674 for MYHEALTH CARD for "computer software used to input, store, update, transfer, retrieve, print or write personal health or medical information to or from cards with an embedded integrated circuit chip."⁵

The examining attorney has also made of record a copy of a page from registrant's website located at www.ansyr.com. She maintains that the registrant's goods under the PRIMER mark are described as allowing one to "view, navigate and print documents formatted in Adobe's

⁵ The examining attorney relies on Registration No. 2703859 for OBS and design, but that registration covers computer services, not computer software. It therefore has little probative value on the question of the relationship between applicant's and registrant's computer software.

Other registrations cited by the examining attorney but not identified herein do not recite goods that are particularly related to the goods in issue on this appeal. This includes Registration No. 2243941, which was cancelled on February 11, 2006.

Also, the examining attorney has submitted several applications. We do not consider these applications because applications are only evidence that an applicant has filed for registration of a mark. See *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002).

Portable Document Format, a worldwide standard for electronic distribution"; and concludes that "the registrant's goods read information that is normally available on the internet, directly on pocket pcs." Brief at pp. 5-6. The examining attorney also points out that applicant's website at www.istart.co.nz states that applicant's MAILPRIMER software "works with any email clients across all platforms, operating systems and devices." She concludes that the goods therefore will travel through the same channels of trade; and that both applicant's and registrant's goods are directed to the same consumers, namely, people who use electronic devices to review electronically available information." Brief at p. 6.

Applicant in turn maintains that registrant's goods have nothing to do with messaging; and that they "allow computer files, such as PDF files, to be read on handheld computers and 'Internet appliances.'" Also, applicant maintains that its goods "are Messaging Software, with no mention of document reading or document viewing." Brief at p. 3.

The registrations made of record by the examining attorney have limited probative value. Four of such registrations generally concern the reading and writing of

information, but only one concerns messaging, i.e., Registration No. 2390970 for BEATWARE, involving software for reading, writing, sending and receiving electronic messages, and computer programs for use in word processing. This single registration is insufficient to establish a relationship between the goods. Thus, we cannot agree with the examining attorney that the registrations of record show that "consumers are familiar with seeing software that performs related tasks emanating from a single source" Brief at p. 4.

The record does, however, contain evidence that applicant's and registrant's software may be used on the same "hand-held computers." Specifically, registrant's webpage states:

Primer is the first product to provide PDF viewing capability on a Pocket PC. The software enables users to view, navigate and print documents formatted in Adobe's Portable Document Format, a worldwide standard for electronic document distribution.

"Primer allows Adobe PDF files to be opened and read on a Windows-powered Pocket PC. Consequently, any .pdf file created on a computer - blueprints, word processing documents, images, spreadsheets - can potentially be accessible on the Pocket PC using Primer software.["]⁶

⁶ A "Pocket PC" is defined as a "personal handheld computing device based on specifications designed by Microsoft and running the Microsoft Windows for Pocket PC operating system. Pocket PCs maintain the look of a Windows operating system display screen and offer compact versions of many of the applications that run

Also, applicant's webpage describes registrant's software as follows:

MailPrimer is a fully transparent, secure and scalable technology. It works with any email client across all platforms, operating systems and devices so all your emails look and perform the same regardless of whether they are sent from a Mac, PC, mobile phone or PDA.⁷

It is well settled that "[i]n order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources."

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). Both applicant's and registrant's goods are software which may be used on the same hand-held computers, i.e., Pocket PCs or PDAs. Moreover, even though they have

on Windows-powered personal computers." See *Microsoft Computer Dictionary* (5th ed. 2002).

⁷ A "PDA" is defined as "Acronym for Personal Digital Assistant. A lightweight palmtop computer designed to provide specific functions like personal organization (calendar, note taking, database, calculator, and so on) as well as communications. More advanced models also offer multimedia features." See *Microsoft Computer Dictionary* (5th ed. 2002).

different functions, one for sending a message and any attached documents and one for displaying documents, they serve complementary functions. Thus, we find that they are related.

With respect to the trade channels of the goods involved in this appeal, the examining attorney correctly notes that the identifications of goods do not contain trade channel limitations. Because our determination of the issue of likelihood of confusion between the applied-for and registered marks must be made on the basis of the goods as they are identified in the involved application and registration, and because there are no trade channel limitations in the identification, we presume that the registration encompasses all goods of the nature and type described, and that the identified goods move in all channels of trade that would be normal for such goods, and that they are available to all classes of purchasers for the described goods. *Linkvest*, 24 USPQ2d at 1716; *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus, because both applicant's and registrant's goods may be used on the same devices by the same ultimate user, we conclude that the trade channels for both applicant's and registrant's software overlap and the goods are directed to the same purchasers.

In view of the foregoing, we find that consumers familiar with registrant's "software enabling documents to be read on hand-held computers and Internet appliances" offered under the mark PRIMER would be likely to believe, upon encountering applicant's mark MAILPRIMER, for "[m]ultimedia messaging software; computer software for the writing, sending, storage, processing, control, organization and/or management of email and other forms of communication," that both originate with or are somehow associated with the same entity. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.